

REMARKS

No claims are amended or added, claims 10 - 28 are canceled,; as a result, claims 1 - 9 are now pending in this application.

Double Patenting Rejection

Claims 10-28 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,196,459.

Applicant respectfully disagrees with the rejection of claims 10 - 28. Nevertheless, Applicant has elected to cancel claims 10 - 28 solely for the purpose of expediting the patent application process. Applicant specifically reserves the right to file a continuation application at a later date to reintroduce these claims.

§102 Rejection of the Claims

Claims 1-9 were rejected under 35 USC § 102(b) as being anticipated by Linden (U.S. 4,827,425).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because the reference does not teach each and every claim element.

Independent claim 1 includes the act of "receiving a card object from a card issuer management system" that is not disclosed in Linden. The card issuer management system manages the cardholder data and determines the type of card to issue, the card applications to embed in the card, and what personalization equipment to use to issue the card for a particular cardholder. (Applicant's Specification, page 7, lines 10-12). Linden does not disclose any selective programming of this sort. Instead, the cards are programmed with data corresponding to the data encoded on the magnetic strips earlier in the assembly line. (Linden, col. 3 line 65 to col. 4 line 12).

Independent claim 1 also includes "receiving a programming request. . .". There is no programming request in Linden. In contrast, it is assumed that all of the cards are to be programmed as they travel through the in-feed, rotate once around the circular programming table, and then exit through the out-feed. (Linden, col. 3 line 38 to col. 4 line 37).

Thus, Linden does not teach each element of claim 1. In addition, claims 2 - 9 depend, directly or indirectly, on claim 1 and are patentable over Linden for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination.

Documents Cited but Not Relied upon for this Office Action

Applicant need not respond to the assertion of pertinence stated for the reference cited but not relied upon by the Office Action since this reference is not made part of the rejection in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date Nov. 18, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of November, 2005.

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